

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed March 3, 2005 ("Office Action"). Claims 1-25 are pending in the present application and currently stand rejected.

I. Section 112 Rejections

The Examiner rejected Claim 16 for lack of antecedent basis. Appropriate amendments have been made. Accordingly, Applicant requests removal of this rejection.

II. Section 103 Rejections

The Examiner rejected Claims 1-8, 12-19, and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,907,490 issued to Oliver ("*Oliver*"), in view of U.S. Patent Publication No. 2002/0052770, listing Podrazhansky as an inventor ("*Podrazhansky*"). The Examiner additionally rejected Claims 9-11 and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over *Oliver*, in view of *Podrazhansky*, in further view of U.S. Patent Application No. 6,574,605 B1 issued to Sanders et al. ("*Sanders*"). Applicant respectfully traverses these rejections for the reasons stated below.

1. The Proposed *Oliver- Podrazhansky* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Claim 1

A *prima facie* case of obviousness requires a teaching or suggestion of all the claim limitations. The combination of the *Oliver* and *Podrazhansky* references as suggested by the Examiner fails to disclose at least the following limitation of Claim 1:

determine schedule recovery date (SRD) information from the
project task data and earned value information; and
display the schedule recovery date (SRD) information

The Examiner acknowledges in the current Office Action that *Oliver* does not disclose, teach, or suggest "schedule recovery date (SRD) information." Office Action, Page 5 ("Oliver does not explicitly disclose determining schedule recovery date (SRD)

information”). Instead, the Examiner relies on *Podrazhansky* for disclosure of this feature, stating the following:

Podrazhansky discloses displaying the aggregate cost of the schedule for a defined time period, selectable by the user (§ 0054). Further, Podrazhansky discloses workload drivers being time constrained (i.e., date, time of day, etc.), wherein Podrazhansky derives staffing requirements that optimally satisfy the forecasted workload volume in view of the workload drivers (§§ 0031-32).

(Office Action, Page 5). Applicant submits that even if the above were disclosed in *Podrazhansky* that such a disclosure does not disclose schedule recovery date (SRD) information as recited in Claim 1. *Podrazhansky* is directed towards forecasting a future workload and formulating a schedule to meet the future workload. Such is succinctly describe in *Podrazhansky* as follows:

Receiving the workload volume, the present invention 10, forecasts a prediction of future workload volume(s). The prediction is derived from at least one condition or limitation that is imposed on the forecast by the user . . . The conditions are defined herein as workload drivers, i.e., conditions, once applied, affect the volume of work expended on the selected organization's behalf.

(*Podrazhansky* , Paragraph 31)

The present invention 10 formulates a schedule reflecting the staffing requirement in view of the workload volume drivers. The schedule may, if desired, provide the user with an actual representation of forecasted volume of work and the expected staffing requirements to perform work on the organization's behalf. The user may, if desired, apply a plurality of tools that enable costing of the forecasted volume of work and the expected staffing requirements required to perform work.

(*Podrazhansky*, Paragraph 32). This formulation of a schedule to meet the future workload certainly does not disclose schedule recovery date (SRD) information, nor does it disclose why *Podrazhansky* would be interested in such schedule recovery date (SRD) information. Thus, Applicant submits that the combination of *Oliver* and *Podrazhansky* as suggested by the Examiner, fails to teach or suggest all the claim limitations of Claim 1. For at least this reason, Claim 1 is allowable.

Independent Claim 14 recites certain limitations that are similar, although not identical, to limitations of Claim 1. Therefore, Claim 14 is allowable over the cited references for analogous reasons.

Applicant's dependent claims are allowable based on their dependence on the independent Claims 1 and 14 and further because they recite numerous additional patentable distinctions over the cited reference of the rejection. Because Applicant believes he has amply demonstrated the allowability of independent Claims 1 and 14 over the cited references of the rejection, and to avoid burdening the record, Applicant has not provided additional detailed remarks concerning these dependent claims. Applicant, however, remains ready to provide such remarks if it becomes appropriate to do so. Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 1-25.

2. The Proposed *Oliver-Podrazhansky* Combination is Improper

A *prima facie* case of obviousness additionally requires a motivation to combine the references. Even assuming for the sake of argument that *Oliver* and *Podrazhansky* disclosed each and every element of the invention defined by Claims 1, there is no motivation to combine them. The Examiner's motivation to combine *Oliver* and *Podrazhansky* was indicated in the Office Action as follows:

"Both *Oliver* and *Podrazhansky* are concerned with effective scheduling management, therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include SRD information in *Oliver*, as seen in *Podrazhansky*, in order to efficiently determine current scheduling costs, thereby allowing management to make more effective decisions."

(Office Action, Page 4).

. . . *Podrazhansky* discloses that it would be desirable to have a scheduling and project management system that is flexible and could be implemented across various industry requirements, wherein the system would be modular allowing a company to add specific modules to accommodate specific needs (§ 0008). Therefore, although the Examiner feels that motivation is found in the knowledge generally available to one

of ordinary skill in the art, Podrazhansky provides additional motivation to combine the references.

(Office Action, Page 10). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See, e.g., In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at the claimed...salt.”). Applicant submits that the above motivation lacks the requisite evidence of a motivation to combine.

With regards to the former of the above statements, the fact that both references relate to project management does not, in and of itself, provide a motivation to combine. Additionally, an alleged motivation stemming from more efficient project management is simply hindsight reconstruction. Nothing in either *Oliver* or *Podrazhansky* suggests that the disclosure therein standing alone has efficiency problems.

With regards to the latter of the above statements, Applicant notes that *Podrazhansky*’s recitation states that specific modules are utilized to accommodate specific needs. Accordingly, such a recitation does not provide the requisite motivation to combine with the other references. Additionally, as the Examiner is relying upon “common knowledge” or “well known” principles to supply the required motivation or suggestion to modify the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If the Examiner’s personal knowledge is being relied on to supply the required motivation or suggestion to modify, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

3. Lack of Establishment of Proper Support in a Priority Document for the Subject Matter Utilized in Rejection

As previously indicated, *Podrazhansky* has an actual filing date after the filing date of the current Application. Therefore, *Podrazhansky* cannot be used to reject the claims

under 102(e) or 102(e)/103 unless there is "proper support for the subject matter as required by 35 U.S.C. 119(e) or 120" in a priority document with a filing date earlier than the present Application (and subject to any possible swear behind). *See* M.P.E.P. §706.02, Example 2 and M.P.E.P. §2136.03. The Office Action indicates that Examiner believes that proper supports exists in the provisional application. Accordingly, Applicant requests evidentiary support of the elements in the provisional application intended to provide "proper support for the subject matter" in *Podrazhansky* utilized in rejecting the claims, including but not limited to, a support for the Examiner's alleged motivation to combine (e.g., ¶ 0008 of *Podrazhansky*). Additionally, should this rejection be maintained upon the above establishment, Applicant reserves the right to swear behind the provisional application to which *Podrazhansky* claims priority.

Applicant believes this will be unnecessary, however, as the obviousness rejections should be overcome as indicated above.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

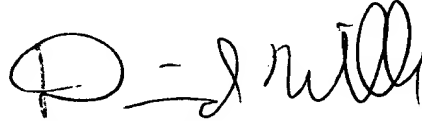
Applicant does not believe any fees are due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,

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